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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/623,023	10/20/2000	Keiji Hashimoto	107016	5472

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EXAMINER
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TSANG FOSTER, SUSY N

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 02/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/623,023

Applicant(s)

HASHIMOTO ET AL.

Examiner

Susy N Tsang-Foster

Art Unit

1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 9,13,14 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13,14 and 17 is/are allowed.
- 6) ☒ Claim(s) 9,18,19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 11/6/2003 is: a) ☐ approved b) ☒ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/19/2003 has been entered.

### ***Response to Amendment***

2. This Office Action is responsive to the amendment filed on 11/6/2003. Claims 9, 13, 14, and 17-19 are pending. Claims 13, 14, and 17 are allowed. Claims 9, 18, and 19 are rejected for reasons given below.

### ***Drawings***

3. The drawings are objected to because proposed changes for Figure 5 are missing from the proposed drawing corrections filed on 11/6/2003. It is advised to the applicant that proposed changes for Figures 1 and 5 must be submitted together for informalities indicated in the previous office actions. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 9, 18, and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 9, the recited feature “wherein the first and second separators each are divided into a second plurality of spaced plates in contact with the divided electrode plates, and wherein the current-collecting plates each are divided into third plurality of spaced plates in contact with the divided separators” is new matter because divided separator plates are not supported in the original disclosure. Detailed reasons for the lack of support for this feature in the original disclosure is given below in the response to arguments section of this Office Action.

In claims 18 and 19, the recited feature “wherein the current-collecting plates are each divided into a second plurality of spaced plates placed in contact with the divided first and second separators” is new matter because divided separator plates are not supported in the original disclosure. Detailed reasons for the lack of support for this feature in the original disclosure is given below in the response to arguments section of this Office Action.

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6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 18 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 recites the limitation "the divided first and second separators" in the last line of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claims depending from claims rejected under 35 USC 112, second paragraph are also rejected for the same.

#### ***Response to Arguments***

8. Applicant's arguments filed 11/6/2003 have been fully considered but they are not persuasive.

*Applicant asserts that the feature "the first and second separators each are divided into a second plurality of spaced plates in contact with the divided electrode plate" as recited in claim 9 and the feature "divided first and second separators" recited in claim 18 are supported by page 10, line 6 through page 11, line 4 of the substitute specification filed on July 10, 2002.*

In response, the Examiner reviewed the corresponding portions of the specification which applicant asserts supports these features claimed in claims 9 and 18. The Examiner did not find

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support for these features. Instead, the specification at page 10, line 6 through page 11, line 4 discloses that the space between the left-hand solid electrolytic membrane 24 and the left-hand support plate 22 is subdivided by the flat plate 26a of the left-hand separator 26 into a reaction chamber R1 which is exposed to the electrode plate 25a and supplied with the fuel gas, while the space between the right-hand solid electrolytic membrane 24 and the right-hand support plate 22 is subdivided by the flat plate 26a of the right-hand separator 26 into reaction chamber R2 which is exposed to the electrode plate 25b and supplied with the oxidizing agent gas. This part of the specification corresponds to Figure 6 and does not support the claimed features in claims 9 and 18. This portion of the specification does not support the feature that the separator is divided. The separator divides the space between a surface of the solid electrolytic membrane and a support plate and the separator itself is not divided.

#### ***Allowable Subject Matter***

9. Claims 13, 14, and 17 are allowed for reasons of record.

#### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications should be directed to examiner Susy Tsang-Foster, Ph.D. whose telephone number is (571) 272-1293. The examiner can normally be reached on Monday through Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached at (571) 272-1292.

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The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

st/ 

Susy Tsang-Foster  
Primary Examiner  
Art Unit 1745